

REMARKS

Applicants acknowledge receipt of the *Office Action* dated July 5, 2005 wherein claims 1-11, 13-26 and 28-30 were rejected under 35 U.S.C. § 102(b); and claims 12 and 27 were rejected under 35 U.S.C. 103(a).

Status of the Claims

Claims 1 and 16 are currently amended.

Claims 2-15 and 17-30 are in original form.

Claim Rejections under 35 U.S.C. § 102(b)

Hebert Reference

Claims 1-4, 7-11, 13-19, 22-26 and 28-30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,878,818 to Hebert et al. (hereinafter *Hebert*). *Hebert* discloses a mechanically set anchor 14 comprising a housing 16 containing three anchor slips 22 that are actuatable into and out of the housing through three axially aligned slots 18 positioned about 120 degrees apart (col. 5, lines 11-17). In operation, a slip actuating ring 44 strikes a slip drive ring 41, which in turn pushes against the slips 22 to drive them through the slots 18 in the housing (col. 5, lines 57-60). Ramped surfaces 26 formed by the slips 22 are driven up a conical ramp surface 19 formed by the housing 22 to force the slips 22 into engagement with the steel pipe casing 7, thereby anchoring the mechanical set anchor into place within the cased borehole (col. 5, lines 61-65).

As set forth in MPEP §706.02(IV), in order for a reference to anticipate the invention as claimed, the reference must disclose each and every element recited in the claims. The Patent Office takes the position that *Hebert* discloses the “plurality of angled channels” recited by claim 1 and claim 16, namely, the axial slots 18 and the ramp surface 19 in the housing 16 along which slips 22 translate between a collapsed position (Figure 2) and an expanded position (Figure 4). Applicants respectfully traverse the Examiner’s characterization of the *Hebert* axial slots 18 and/or the ramped surface 19 as corresponding to the claimed “plurality of angled channels.” In particular, the axial slots 18 are vertical instead of angled, the slots 18 are formed through rather than into a wall of the body, and the slips 22 translate through the slots 18 rather than along

them. Further, the ramp surface 19 is not structurally or functionally equivalent to the claimed plurality of angled channels. Structurally, the *Hebert* ramp surface 19 extends outwardly from the housing 16 wall at an angle, whereas the claimed "plurality of angled channels" are formed into the wall of the body or the slip housing. Functionally, due to the differences in design between the *Hebert* ramp surface 19 and the claimed channels, the slips 22 of *Hebert* move against the ramp surface 19, whereas the "plurality of moveable slips" of claim 1, or "at least one pair of individual slips" of claim 16, are designed to travel in the plurality of channels as they translate along the channels between the collapsed position and the expanded position. Thus, the claimed slips are interconnected with the body of claim 1 or the slip housing of claim 16, and this interconnection provides an increased surface area of contact for a more robust expandable tool. Further, this placement of the plurality of the angled channels enables an interconnection between the slips and the body or the slip housing such that the channels support the slips in the expanded position. Accordingly, Applicants submit that at least for these reasons, *Hebert* fails to disclose each and every element recited in the pending claims, and therefore independent claim 1 and independent claim 16 are each patentably distinguishable over *Hebert*. Further, claims 2-4, 7-11 and 13-15 are in condition for allowance over *Hebert* at least because each of these claims depend from allowable claim 1. Likewise, claims 17-19, 22-26 and 28-30 are in condition for allowance over *Hebert* at least because each of these claims depend from allowable claim 16.

Link Reference

Claims 1, 5, 6, 20 and 21 further stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 3,397,746 to Link (hereinafter *Link*). *Link* discloses a deflecting tool 6 positioned within a pipe or casing 1. The deflecting tool 6 includes a wedge body 7 formed with an inclined or cam surface. A spear 9 is mounted on the lower end of the wedge body 7 and is provided with teeth or wickers 10 that are forced into the wall of a liner 3 below the wedge body 7 by the weight of the tool 6, thereby securely holding the deflecting body 7 in position. Slips 11 are also slideably mounted in a wedge shaped upper end 12 of the spear 9. The slips 11 are pressed downwardly to engage the casing 1 by a coil spring 13, which engages a spider 14 positioned on top of the slips 11 (col. 1, line 68 to col. 2, line 14).

As set forth in MPEP §706.02(IV), in order for a reference to anticipate the invention as claimed, the reference must disclose each and every element recited in the claims. Applicants

respectfully submit that *Link* fails to teach or suggest a plurality of moveable slips that are positioned entirely within the body in the collapsed position in accordance with amended claim 1, or individual slips that do not extend radially beyond the at least one slip housing in the collapsed position in accordance with amended claim 16. Instead, *Link* discloses slips 11 that are mounted around a wedge shaped upper end 12 of the spear 9. Given such a configuration, the slips 11 will always be positioned outside of, or extend radially beyond, the upper end 12 of the spear 9 in both the collapsed and expanded positions. Therefore, at least for these reasons, *Link* fails to disclose each and every element recited in the pending claims. Accordingly, independent claim 1 and independent claim 16 are each patentably distinguishable over *Link*. Further, claims 5 and 6 are in condition for allowance over *Link* at least because each of these claims depend from allowable claim 1. Likewise, claims 20 and 21 are in condition for allowance over *Link* at least because each of these claims depend from allowable claim 16.

Claim Rejections under 35 U.S.C. § 103 (a)

Claims 12 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hebert* in view of U.S. Patent No. 6,165,377 to Roberts (hereinafter *Roberts*). The basis for this rejection is that *Hebert* discloses slips 2 with gripping engaging means 23, 24; and *Roberts* discloses slips having carbide inserts 28 to dig into the inner wall of the casing. Therefore, the *Office Action* states that it would have been obvious to one having ordinary skill in the art to provide the *Hebert* slips 22 with the carbide inserts 28 disclosed by *Roberts*.

In response, Applicants respectfully submit that the combination of *Hebert* and *Roberts* does not establish a *prima facie* case of obviousness as to pending claims 12 and 27. According to MPEP 2142, three basic criteria must be met to establish a *prima facie* case of obviousness:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.


Even assuming for the sake of argument that the combination of *Hebert* with *Roberts* is proper (without conceding such), Applicants submit that no *prima facie* case of obviousness has been established with respect to pending claims 12 and 27 at least because such a combination fails to teach or suggest all of the claim limitations. In particular, claim 12 depends from and incorporates the limitations of independent claim 1, and as previously presented, *Hebert* does not disclose the claimed "plurality of angled channels". Similarly, claim 27 depends from and incorporates the limitations of independent claim 16, and as previously presented, *Hebert* does not disclose the claimed "plurality of angled channels." *Roberts* is cited by the Examiner to show slips having carbide inserts, and not to show a plurality of angled channels. Therefore, given that *Hebert* does not teach a plurality of angled channels and thus does not make obvious each and every element of claim 12 and 27, and *Roberts* does not make up for the lack of teaching of *Hebert*, claims 12 and 27 are not obvious in view of the prior art of record.

CONCLUSION

Consideration of the foregoing amendments and remarks, reconsideration of the application, and withdrawal of the rejections is respectfully requested by Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the *Office Action* dated July 5, 2005 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to telephone the undersigned at the telephone number given below.

Respectfully submitted,


SHANNON W. BATES
Reg. No. 47,412
CONLEY ROSE, P.C.
5700 Granite Parkway, Suite 330
Dallas, Texas 75024
(972) 731-2288
ATTORNEYS FOR APPLICANTS